

REMARKS

I. THE REJECTION OF CLAIMS 1 AND 4-7 UNDER 35 U.S.C. 102(B) AS BEING ANTICIPATED BY APPLICANT PROVIDED PRIOR ART (TI AMO) IS IN ERROR.

In the office action of March 8, 2005, the examiner stated: "Claims 1 and 4-7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Applicant provided prior art (Ti amo)."

P. 3, Office Action. Applicants traverse this rejection for the following reasons. The applicants have added amendments to claims 1 and 4-7 that overcome the above rejection. Such amendments are made without prejudice to the applicants filing of a continuation application that will seek broader patent protection than the presently amended claims. Such amendments should not be considered to be nor are they a clear and express disavow of the subject matter therein

Turning to a review of Ti amo, no data is present therein as to the specific claimed inside and outside viscosity ranges on the recited products. As the examiner stated:

"The prior art cited by the applicant has not provided complete details of the prior art. Thus, the examiner is requesting that applicant provided any additional non-patent documents or patents that will assist the examiner in the prosecution of this case."

P. 3, Office Action. Based on information and belief, Applicants do not have presently any additional information as to constituents of lubricant viscosity of any SSL products that were made, used or sold prior to Applicants' filing date – other than the allegations set forth by SSL in its letter of October 20, 2004, and related correspondence submitted in an IDS filed concurrently herewith. What SSL first alleged in October 2204 was that SSL products since 1982 have a high viscosity sensitizing cream applied to the inside of the condom, and a low viscosity oil

applied to the outside of the condom. SSL further alleged that Dr. Harrison was fully aware of these facts during a visit to SSL's facility in Italy.

Contrary to such allegations, Dr. Harrison's visit to Casalecchio di Reno (outside Bologna) at the SSL manufacturing facility addressed other matters. Dr. Harrison did not address any specifics of the Ti amo— nor was he aware of any specific inside or outside viscosities of desensitizing condoms then sold by SSL. SSL stated allegations are without merit.

Since the specific viscosity of the lubricants could best be provided by SSL, a letter was sent to SSL's attorney requesting such information as to constituents of Ti amo. In reply, Mr. Schechter on behalf of SSL stated that his client's "inside" Benzocaine-in-PEG delaying cream (5% Benzocaine and 95% PEG) has always been outside, i.e., far higher than the viscosity range disclosed in the '442 patent application. June 29, 2005 letter Schechter to Shear, listed in the Supplement IDS filed with this amendment and response. Mr. Schechter also stated in his letter that the viscosity of the outside lubricant was about 200 cps. This viscosity of the inside lubricant of SSL products was further confirmed by Mr. Schechter when he stated that his client has no interest in any patent claims reciting an inside viscosity range of 10,000 to 75,000 cps because his clients products are "far outside the viscosity range." June 30, 2005 letter Schechter to Shear, listed on the IDS filed herewith.

SSL has stated in its recent letters that Ti amo has inside and outside viscosity ranges that are outside of the scope of the present claims. For this reason, subject to the caveats set forth below, claims 1 and 4-7 are patentable over the Ti amo reference.

With this said, it should be understood that applicants continue to seek further information on actual inside and outside viscosity ranges of the identified SSL products – and specifically Ti amo, which predate the present filing date. At this stage of prosecution applicants

cannot confirm or deny the accuracy of SSL allegations as to the 1982 Ti amo product or later products that predate the present filing date.

Out of an abundance of caution, and solely for the purpose of advancing prosecution, the applicant is assuming *arguendo* the accuracy of such SSL's statements, and has amended the claims accordingly. However, such should not be considered a clear disavow or any disclaimer of broader claims that the applicant may seek in a continuation application.

II. THE REJECTION OF CLAIMS 2-3, 8-10, 12-17 AND 19-20 ARE REJECTED UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER APPLICANT PROVIDED PRIOR ART (TI AMO) IS IN ERROR.

In the Office Action the examiner rejected claims 2-3, 8-9, 10-17 and 19-20 under 35 U.S.C. 103(a) as being unpatentable over Applicant provided prior art (Ti amo). According to the examiner:

“Applicant provided prior art discloses a condom, substantially as claimed. However, Applicant provided prior art further discloses that the present invention is old and well known over the last twenty years. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the viscosity of the first lubricating composition could be about 10,000 to 75,000 cps and the viscosity of the second lubricating composition could be about 500 to 20,000 cps or the viscosity of the first lubricating composition could be about 10,000 to 25,000 cps and the viscosity of the second lubricating composition could be about 2,000 to 6000 cps in order to make the

compositions of a certain viscosity. The first and second lubricating composition could be composed of the different percentages of w/w recited in claims 17 and 20. It is old and well known to place a condom between two foil sheets.”

Pp. 2-3, Office Action. The examiner has stated (or noted) that no specific inside or outside lubricant viscosities are set forth in Ti amo. Further, assuming *arguendo* that SSL statements in its letters are correct, the conclusion drawn is that:

(i) Ti amo shows only an inside viscosity of a Benzocaine-in-PEG delaying cream (5% Benzocaine and 95% PEG) far higher than the presently claimed range of 10,000 to 75,000; and

(ii) the viscosity range of the outside lubricant of about 200 cps, which is less than recited range of 500 to 20,000 cps, and much less than the recited range of 2,000 to 6,000.

Importantly, while the examiner alleges the recited viscosity range of the inside lubricant of the present claims is obvious to one of skill in the art, it is apparent that no actual viscosity ranges of the inside or outside lubricants are disclosed in Ti amo. Fairly, if followed, the examiner’s logic would suggest that not only is the “unknown” inside range of the Ti amo prior art lubricant obvious to one of skill in the art, but that any inside lubricant viscosity ranges is obvious to one of skill in the art. This is failed logic because the starting point of an unknown viscosity range cannot by hindsight result in the presently recited viscosity range of the present claims.

Further, assuming the correctness of SSL statements as to Ti amo, nowhere is there any motivation in Ti amo to adjust outside viscosity range upward and far lower than the purported range of SSL Ti amo, and yet, at the same time adjust the outside viscosity range far higher than the purported range in Ti Amo. Such changes in the inside and outside viscosity alleged to be Ti amo could only be considered to be the application of impermissible hindsight. See In re Zurko, 111 F.3d 887 (Fed. Cir. 1997), citing W.L. Gore & Assocs., Inc. v. Garlock, ... (Fed. Cir. 1983) (“To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only inventor taught is used against its teacher.”)

There can be no question that Ti amo fails to provide any motivation to adjust the inside and outside lubricant viscosity ranges in the differing directions much less recite the specific ranges. For these reasons, claims 2-3, 8-9, 10-17 and 19-20 are patentable over Ti amo.

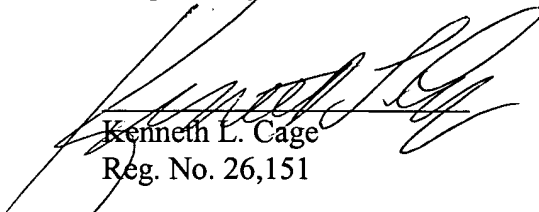
III. CONCLUSION

For the above reasons, a notice of allowance is solicited. Absent a forth coming notice of allowance, Applicants request an interview with the examiner to review any outstanding issues so that prosecution may be appropriately advanced. The courtesy of the examiner in granting an interview will be appreciated.

Finally, applicant wishes to again advise the examiner that a continuation application is planned to be filed where claims of a broader scope will be sought. By the present amendments, no disavow or disclaimer of the scope of the invention is intended as additional protection will be sought in the continuation application. Such a step will provide applicant sufficient time to

review and gather additional information on the viscosity ranges of the Ti amo disclosure of
SSL, and take appropriate action to protect the invention or inventions disclosed in the present
application.

Respectfully Submitted,



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